

REMARKS

Claims 1-19 are pending in this Application and Claim 21 being added. No new matter is added by way of these amendments, and the amendments are supported throughout the Specification and the drawings. Reconsideration of Claims 1-19 and favorable consideration of Claim 21 is respectfully requested.

The Examiner's rejections will be considered in the order of their occurrence in the Official Action.

Paragraph 1 of the Official Action

The Official Action objected to the drawings for failing to show an "obtuse angle." An obtuse angle is an angle between 90 and 180 degrees. Figure 6 and the other figures clearly shows this obtuse angle. The Applicant has attached a marked-up Figure 6 as Exhibit A for the Examiner to consider. The Applicant respectfully submits that no modifications are required in the drawings to illustrate the obtuse angle.

Paragraph 2 of the Official Action

The Official Action rejected Claim 20 under 35 U.S.C. §112, second paragraph as being indefinite. The Applicant has deleted Claim 20 making this rejection moot.

Paragraph 3 of the Official Action

The Official Action rejected as-filed Claims 1, 9, 10 under 35 U.S.C. §102(b) as being anticipated by Klammer (U.S. Patent No. 6,108,990). The Applicant respectfully disagrees with this rejection.

It is important to first briefly discuss 35 U.S.C. §102 and its application to the present application. Under section 102(b), anticipation requires that the prior art reference disclose, either expressly or under the principles of inherency, every limitation of the claim. But to be prior art under section 102(b), a reference must be enabling. . . . That is, it must put the claimed

invention in the hand of one skilled in the art. . . . **The examiner bears the burden of presenting at least a prima facie case of anticipation.** In re Sun, 31 USPQ 2d 1451, 1453 (Fed. Cir. 1993) (unpublished). An anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed and that its existence was recognized by persons of ordinary skill in the field of the invention. ATD Corp. v. Lydall, Inc., 48 USPQ 2d 1321, 1328 (Fed. Cir. 1998).

Under 35 U.S.C. §102, anticipation requires that **each and every element** of the claimed invention be disclosed in the prior art . . . In addition, the prior art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public. Akzo N.V. v. United States Int'l Trade Comm'n, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986), cert. denied, 482 U.S. 909 (1987) (emphasis added). Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. W.L. Gore & Assocs. v. Garlock, Inc., 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim*. Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir. 1984).

When more than one reference is required to establish unpatentability of the claimed invention anticipation under § 102 can not be found, and validity is determined in terms of § 103. Continental Can Co. USA v. Monsanto Co., 20 USPQ 2d 1746, 1748 (Fed. Cir. 1991).

Section 102(a) establishes that a person can not patent what was already known to others. If the invention was known to or used by others in this country before the date of the patentee's invention, the later inventor has not contributed to the store of knowledge, and has no entitlement to a patent. Accordingly, in order to invalidate a patent based on prior knowledge or use, that knowledge or use must have been available to the public. . . . Therefore, notwithstanding abandonment of the prior use -- which may preclude a challenge under § 102(g) -- prior knowledge or use by others may invalidate a patent under § 102(a) if the prior knowledge or use was accessible to the public. . . . Section 102(b), unlike § 102(a), is primarily concerned with the policy that encourages an inventor to enter the patent system promptly, while recognizing a one year period of public knowledge or use or commercial exploitation before the patent application must be filed. Thus an

inventor's own prior commercial use, albeit kept secret, may constitute a public use or sale under § 102(b), barring him from obtaining a patent. . . . However, when an asserted prior use is not that of the applicant, § 102(b) is not a bar when that prior use or knowledge is not available to the public.

Woodland Trust v. Flowertree Nursery, Inc., 47 USPQ 2d 1363, 1365-66 (Fed. Cir. 1998).

The Examiner states that Klammer teaches a "first and second angled sections (see attached figure 1) extending from opposing edges of the middle section (by 12 and 14) at an obtuse angle (see attached figure 1) with respect to the inner surface (where 15 points to) . . ." The Applicant respectfully disagrees with the Examiner's interpretation of Figure 1 of Klammer. Figure 1 clearly shows an angle greater than 180 degrees which is not an obtuse angle (obtuse angles are between 90 and 180 degrees). Figures 3 and 5 of Klammer further illustrate that the angle is not *obtuse*.

Claim 1 expressly claims an "obtuse angle" which is not shown in any of the prior art references. The Applicant has attached Exhibit A which fully illustrates this obtuse angle. This is a significant limitation of independent Claim 1 which should be seriously considered by the Examiner in determining the allowability of Claim 1 and its respective dependent Claims.

The Applicant respectfully submits that Klammer does not qualify as appropriate prior art under 35 U.S.C. §102(b) as Klammer does not disclose all of the elements of independent Claim 1. With respect to Claim 20 being rejected by Kelly (U.S. Patent No. 4,876,837), the Applicant has deleted this claim without prejudice.

Paragraph 4 of the Official Action

A. Overview

The Official Action rejected Claims 1-19 under 35 U.S.C. §103(a) as being unpatentable over Gunti (U.S. Patent No. 4,172,677), Klammer (U.S. Patent No. 6,108,990), Ganssle (U.S. Patent No. 4,392,336) and Paoletti (U.S. Patent No. 3,675,383). The Applicant respectfully

disagrees with this rejection of these claims. The Applicant incorporates by reference the above-stated arguments with respect to Klamer into this section.

B. Legal Standard

In proceedings before the United States Patent and Trademark Office, the Examiner bears the burden of establishing a *prima facie* case of *obviousness* based upon the prior art. In re Bell, 26 USPQ2d 1529, 1530 (Fed. Cir. 1993). In re Oetiker, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). When references cited by the Examiner fail to establish a *prima facie* case of obviousness, the rejection is improper and will be overturned upon appeal. In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

The law regarding *obviousness* is clear -- any modification of the prior art must be suggested or motivated by the prior art. It is submitted that combining elements from different prior art references (in an attempt to establish obviousness) must be motivated or suggested by the prior art.

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.’ [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious “modification” of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.”

In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious--there must be a motivation provided by the prior art, and that motivation is totally lacking in the reference.

"The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape *** since *this is within the capabilities of such a person.*" Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason."

Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980) (emphasis in original).

Gunti (U.S. Patent No. 4,172,677)

Gunti merely teaches a "load-bearing scaffold". **Gunti** is not related to the drywall industry, much less related to a "drywall butt joint system" as the invention specifically relates to. Hence, **Gunti** is non-analogous to the present invention as claimed and should not be considered in determining the allowability of the claims.

"The determination that a reference is from a non-analogous art is . . . twofold. First, we decide if the reference is **within the field of the inventor's endeavor**. If it is not, we proceed to determine whether the reference is **reasonably pertinent to the particular problem with which the inventor was involved.**" *In re Wood*, 202 USPQ 171, 174 (C.C.P.A. 1979). "A reference is **reasonably pertinent** if . . . it is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering his problem. . . . If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, . . . [i]f it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it." *In re Clay*, 23 USPQ 2d 1058, 1060-61 (Fed. Cir. 1992).

Gunti is not in the "field of the inventor's endeavor" (i.e. "drywall butt joint system"). Secondly, **Gunti** is not "reasonably pertinent to the particular problem with which the inventor

was involved” (i.e. for recessing a butt joint between two sheets of drywall). Gunti is non-analogous to the present invention and should not be considered.

The Applicant also respectfully submits the following case law in support that the prior art stated in the Official Action is non-analogous:

- “In resolving the question of obviousness under 35 USC 103, we presume full knowledge by the inventor of all the prior art in the field of his endeavor. However, with regard to prior art outside the field of his endeavor, we only presume knowledge from those arts reasonably pertinent to the particular problem with which the inventor was involved. . . . The rationale behind this rule precluding rejections based on combination of teachings of references from nonanalogous arts is the realization that an inventor could not possibly be aware of every teaching in every art.” In re Wood, 202 USPQ 171, 174 (C.C.P.A. 1979).
- “In the instant application, the examiner has done little more than cite references to show that one or more elements or subcombinations thereof, when each is viewed in a vacuum, is known. The claimed invention, however, is clearly directed to a combination of elements. That is to say, appellant does not claim that he has invented one or more new elements but has presented claims to a new combination of elements. To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. . . . Based upon the record before us, we are convinced that the artisan would not have found it obvious to selectively pick and choose elements or concepts from the various references so as to arrive at the claimed invention without using the claims as a guide. It is to be noted that simplicity and hindsight are not proper criteria for resolving the issue of obviousness.” Ex parte Clapp, 227 USPQ 972, 973 (B.P.A.I. 1985).
- “We have reminded ourselves and the PTO that it is necessary to consider “the reality of the circumstances” . . . —in other words, common sense—in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.” In re Oetiker, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992).
- “The Allen-Bradley art is not in the same field of endeavor as the claimed subject matter merely because it relates to memories. It involves memory circuits in which modules of varying sizes may be added or replaced; in contrast, the subject patents teach compact modular memories. . . . Wang’s SIMMs were designed to provide compact computer memory with minimum size, low cost, easy repairability, and easy expandability. . . . In contrast, the Allen-Bradley patent relates to a memory circuit for a larger, more costly industrial controller. . . . Thus, there is substantial evidence in the record to support a finding that the Allen-Bradley prior art is not reasonably pertinent and is not analogous.” Wang Labs., Inc. v. Toshiba Corp., 26 USPQ 2d 1767, 1773 (Fed. Cir. 1993).

D. Ganssle (U.S. Patent No. 4,392,336)

The Official Action states that “Ganssle teaches that it is known in the art to provide a drywall butt joint system (20) made of metal material.” The Applicant admits that Ganssle teaches this limitation, but denies that Ganssle provides any further structure/function that is related to the present invention as claimed.

E. Paoletti (U.S. Patent No. 3,675,383)

The Official Action states that “Paoletti teaches that it is known in the art to provide a drywall butt joint system (16) made of plastic material.” The Applicant admits that Paoletti teaches this limitation, but denies that Paoletti provides any further structure/function that is related to the present invention as claimed.

F. Conclusion

The Official Action relies heavily upon a non-analogous reference (Gunti) in rejecting Claims 1-19 under 35 U.S.C. §103(a). As stated previously, Gunti should not be considered by the Examiner in determining the allowability of Claims 1-19, 21 since Gunti is non-analogous to the present invention as claimed.

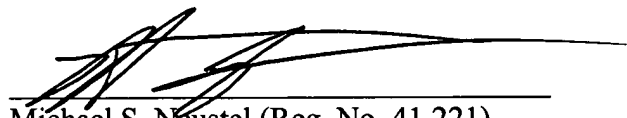
Klamer does not teach an obtuse angle or the first and second supports among other limitations. Hence, Klamer is unable to by itself prevent the allowance of Claims 1-19, 21. For these reasons, among others, the combination of the prior art references cannot suggest the combination of features in applicant's Claims 1-19, and it is therefore submitted that the rejection against these claims should be withdrawn and Claims 1-19 allowed.

Added Claim 21

The Applicant has added independent Claim 21 which has many of the limitations of as-filed Claims 11-19 without the limitation of material type. The Applicant respectfully submits that independent Claim 21 is in condition for allowance.

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited. Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully asked that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. Alternatively should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, they are invited to telephone the undersigned.

Respectfully submitted,



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